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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,836	10/28/1999	YOSHIFUMI TANIMOTO	006332-20011	5195

26021 7590 02/09/2004  
HOGAN & HARTSON L.L.P.  
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SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/09/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/428,836

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-11 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-11 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Notice to Applicant (s)**

1. This action is responsive to the following communications: amendment A filed on 7/8/03.
2. This application has been reconsidered. Claims 4-11 and 15-18 are pending.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 4, 6, 7 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori et al. (Mori) (US 5,982,994).

With regard to claim 4, Mori discloses a network printer (Figure 1, network printer apparatus 20) which is connected to a network (Figure 1, communication path 53) and performs printing based on printing requests from clients (client 52) also connected to the network (col 6, lines 31-39; lines 54-67), the network printer comprising: a plurality of paper supply means (Figure 6, paper feed hoppers 1a to 1c; Figure 8, large capacity hopper 6); designating means (spooling controller 21-8) for designating at least one client or job for at least one of the plurality of paper supply means such that one paper supply means is dedicated for one client or job (col 16, lines 12-19); and printing means (printing mechanism 23) for accepting only printing requests from the client(s) or for the job(s) designated by the designating means, and for performing printing according to the accepted request(s) using the respective dedicated paper supply means (col 6, lines 53-67).

With regard to claim 6, Mori also discloses further including means for spooling printing requests from non-designated clients or for non-designated jobs until designation by the designation means is removed (col 23, lines 50-56).

With regard to claim 7, Mori also discloses further including means for refusing printing requests from non-designated clients or for non-designated jobs (col 24, lines 23-33).

With regard to claim 15, Mori discloses a network printer (Figure 1, network printer apparatus 20) responsive to print requests from clients connected to a network

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(col 6, lines 31-39; lines 54-67), comprising: a plurality of paper supplies (Figure 6, paper feed hoppers 1a to 1c; Figure 8, large capacity hopper 6); means (spooling controller 21-8) for dedicating at least one of said paper supplies for a print job of a particular client based on a request from said particular client (col 16, lines 12-19), wherein printing from the paper supply dedicated to the particular client is reserved for a period of time such that others of said clients are prevented from executing print jobs using the dedicated paper supply during the period of time (col 23, lines 50-56).

With regard to claim 16, Mori also discloses wherein the particular client is permitted to perform a plurality of print jobs using the dedicated paper supply such that printing from the paper supply dedicated to the particular client is reserved for a plurality of time periods (col 23, lines 50-56).

With regard to claim 17, Mori also discloses wherein the reservation of the dedicated paper supply by the particular client is terminated once the printing job of the particular client ends (col 23, lines 50-63).

With regard to claim 18, Mori also discloses wherein the reservation of the dedicated paper supply by the particular client is terminable by the particular client (col 22, lines 52-57).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (Mori) (US 5,982,994) in view of Kurozasa (US 6,614,546).

With regard to claim 5, Mori does not teach wherein the plurality of paper supply means includes a manual feed tray.

Kurozasa discloses a printer connected to a network that includes wherein the plurality of paper supply means includes a manual feed tray (Figure 2, manual paper-feed port 80c) (col 4, lines 21-27).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mori to include wherein the plurality of paper supply means includes a manual feed tray as taught by Kurozasa. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mori by the teaching of Kurozasa to provide a manual feed tray on which special paper such as OHP sheets, post card, and unfixed-sized sheets can be set as taught by Kurozasa in col 4, lines 21-27.

With regard to claim 8, Mori discloses a network printer (Figure 1, network printer apparatus 20) which is connected to a network (Figure 1, communication path 53) and performs printing based on printing requests from clients (client 52) connected to the network (col 6, lines 31-39; lines 54-67), the network printer comprising: a plurality of paper supply means (Figure 6, paper feed hoppers 1a to 1c; Figure 8, large capacity hopper 6); designating means (spooling controller 21-8) for designating at least one client or job for at least one of the plurality of paper supply means such that one paper

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supply means is dedicated for one client or job (col 16, lines 12-19); and printing means (printing mechanism 23) for accepting only printing requests from the client(s) or job(s) designated by the designating means, and for performing printing on recording sheets supplied from the paper supply means dedicated therefor (col 6, lines 53-67).

Mori does not specifically teach the paper supply means is capable of holding different types of paper, the type including at least paper size and paper alignment.

Kurozasa discloses a printer connected to a network that includes the paper supply means is capable of holding different types of paper, the type including at least paper size and paper alignment (col 4, lines 21-27).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mori to include the paper supply means is capable of holding different types of paper, the type including at least paper size and paper alignment as taught by Kurozasa. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mori by the teaching of Kurozasa to provide a means for printing on different sized sheets of paper to include special paper such as OHP sheets, post card, and unfixed-sized sheets can be set as taught by Kurozasa in col 4, lines 21-27.

With regard to claim 9, Mori does not teach wherein the plurality of paper supply means includes a manual feed tray.

Kurozasa discloses a printer connected to a network that includes wherein the plurality of paper supply means includes a manual feed tray (Figure 2, manual paper-feed port 80c) (col 4, lines 21-27).

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mori to include wherein the plurality of paper supply means includes a manual feed tray as taught by Kurozasa. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mori by the teaching of Kurozasa to provide a manual feed tray on which special paper such as OHP sheets, post card, and unfixed-sized sheets can be set as taught by Kurozasa in col 4, lines 21-27.

With regard to claim 10, Mori as modified also discloses further including means for spooling printing requests from non-designated clients or for non-designated jobs until designation by the designation means is removed (col 23, lines 50-56).

With regard to claim 11, Mori as modified also discloses further including means for refusing printing requests from non-designated clients or for non-designated jobs (col 24, lines 23-33).

### ***Response to Arguments***

8. Note: The remarks refer to claims 4-11 and 31-34, Examiner understands this to be a typographical error that should read only claims 4-11 since there are no claims 31-34 in the current application.

Applicant's arguments, see page 5, line 9 – page 7, line 35, filed 7/8/03, with respect to the rejection(s) of claim(s) 4-11 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mori et al. (Mori)



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(US 5,982,994) regarding claims 4, 6, 7 and 15-18 and Mori et al. (Mori) (US 5,982,994) in view of Kurozasa (US 6,614,546) regarding claims 5 and 8-11.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

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Twyler Lamb

A handwritten signature in black ink, appearing to read 'Twyler Lamb', with a stylized flourish at the end.

February 4, 2004